

## REMARKS

### I. Introduction

In response to the Office Action dated September 10, 2004, claims 5, 18, and 31 have been cancelled and claims 1, 13, 14, 26, 27, and 39 have been amended. Claims 1-4, 6-17, 19-30, and 32-39 remain in the application. Re-examination and re-consideration of the application, as amended, is requested.

### II. The Cited References

#### A. The Nakano Reference

U.S. Publication No. 2002/0055847, published May 9, 2002 to Nakano et al. disclose a method and apparatus of providing secure transactions on a network. A method of, and apparatus for, doing business transactions on a network, such as the Internet, is described. Purchases are carried out in a secure way such that there is a minimum possibility that the customer's financial or billing information can be stolen. An input device, such as a set top box, television browser, is provided at a customer's location. The input device has a unique identification code. This code is stored on a first server connected to a network, such as the Internet, prior to conducting any transactions. Customer specific financial and/or billing information is also stored on the first server. The customer is then connected to the desired location on the network through a second server to conduct a transaction. The identification code of the input device is also provided to the second server connected to the network. The second server has secure access to the customer specific information located on the first server, for billing the customer. Where the input device is a set top box browser, a smart card port may be provided. As a marketing device, the smart card can be provided by a vendor. The smart card is encoded with the URL location of the vendor's website. A user inserts the smart card into the input device, such as a television set top box browser, to automatically connect to the vendor's website. By using a smart card, information can be downloaded from the vendor's website to the customer's smart card.

#### B. The Hayward Reference

U.S. Publication No. 2003/0023703, published January 30, 2003 to Hayward et al. disclose a context sensitive web-based user support. A method of providing support to a user of a computer peripheral includes sensing a peripheral indicia at a computer and registering the peripheral and downloading from a server additional information about the peripheral based on the peripheral indicia. The peripheral indicia includes any of a model number, a part number, a serial number, a date of manufacturer and a configuration indicia. Registering the peripheral is performed by launching a communications browser to connect to the server. The method also senses a peripheral condition at the computer where the peripheral condition includes either an error code or a code indicative of a consumable reaching a predetermined threshold or both. This method accesses the server at an address defined by the peripheral condition, and the server provides the browser with additional information about the peripheral condition.

#### C. The Kuo Reference

U.S. Publication No. 2003/0120615, published June 26, 2003 to Kuo discloses a process and method for secure online transactions with calculated risk and against fraud. An electronic commerce process that facilitates online transactions among multiple participants, that prevents consumer fraud due to pirated payment card numbers, with calculated risk, involving at least one trusted payment card host (3), where buyer's payment card number is registered and corresponding secret keys are set up. The buyer (1b) initiates an online transaction by selecting a host from a list of hosts that served by the seller's web server (2a). Then, the buyer participant (1a) sends an order online (4), SSL encrypted. The seller participant (2a) receives and decrypts the order, confirms the availability of ordered items, assigns an orderID to the order, and sends a response (5a), SSL encrypted, to the buyer participant (1a) with the assigned orderID. The buyer participant (1a) encrypts and notifies the selected host (3) of this order and orderID, and authorizes the payment (6a) using secret keys. At the same time, the seller participant also encrypts and sends payment approval request (7) for this orderID through the host. The host (3) decrypts and matches up the orderID, retrieves the secret keys, and hashes to obtain the corresponding payment card number. The host then encrypts and send for payment authorization (8a) from the payment card issuer with the payment card number, through payment clearing network. Upon receiving and decrypting the

response (9) back from the payment card issuer, the host (3) encrypts and notifies (10a) the seller participant (2a) of the card issuer's response (9) for the orderID. After fulfilling the order (11,12), the seller participant encrypts and sends for payment capturing (13a) for this order with orderID, through the host and payment network (14a,15,16).

#### D. The Yuen Reference

PCT International Patent Application WO 97/31479, published August 28, 1997 by R Guide Inc. and invented by Henry C. Yuen discloses a two-way interactive television system. Yuen describes a system for two-way communication between a television viewer operating a remote control unit to control a television and a television signal or other information provider located at a central site. A set-top box coupled to a television includes an infrared receiver to receive command signals from the remote control unit, a pager transmitter to transmit messages to the television signal or other information provider, and a pager receiver to receive confirmation messages from the television signal or other information provider. Also included is a controller to control reception of command signals from the remote control unit, reception of a television signal, display of the television signal on the television, translation of the command signals into messages to be sent by the pager transmitter, reception of confirmation messages from the pager receiver, and display of received confirmation messages on the television. Alternatively, the infrared receiver, pager transmitter, pager receiver, and controller are integral with the television.

#### III. Office Action Prior Art Rejections

In paragraphs (1)-(2), the Office Action rejected claims 1, 3-6, 11, 12, 14, 16-19, 24, 25, 27, 29-32, 37, and 38 under 35 U.S.C. § 102(e) as anticipated by Nakano et al., U.S. Publication No. 2002/0055847 A1 (Nakano). In paragraphs (3)-(4), the Office Action rejected claims 2, 9, 15, 22, 28, and 35 under 35 U.S.C. §103(a) as being unpatentable over Nakano. In paragraph (5), the Office Action rejected claims 7, 8, 20, 21, 33, and 34 under 35 U.S.C. §103(a) as being unpatentable over Nakano as applied to claims 1, 14, and 27, and further in view of Hayward et al., U.S. Publication No. 2003/0023703 (Hayward). In paragraph (6), the Office Action rejected claims 10, 23, and 36 under 35 U.S.C. §103(a) as being unpatentable over Nakano as applied to claims 9, 22, and 35, and further in view of Kuo, U.S. Publication No. 2003/0120615 (Kuo). In paragraph (7), the Office

Action rejected claims 13, 26, and 39 under 35 U.S.C. §103(a) as being unpatentable over Nakano in view of Yuen et al., (Yuen).

Applicants respectfully traverse these rejections. The amended claims generally provide a method of delivering purchase information. Specifically, purchase information for a good or service purchased by a user is received in a set top box. The claims detail that the purchase information was obtained through a user communicating with a set top box. The purchase information is then stored in a smart card in the set top box. The set top box is configured to perform various tasks including receiving broadcast signals and enabling the display of the signals on a presentation device (e.g., a television). The box is also enabled to automatically obtain an Internet connection, establish a secure electronic connection (with a server) through the Internet connection, and transmit the purchase information and a smart card identification number to the server. The cited references fail to teach these various claim limitations.

The Office Action relied on Nakano as the primary reference in rejecting the independent claims. In this regard, Nakano was relied upon for teaching the storage of purchase information on a smart card. Specifically, the Office Action provided that the serial number to enable a purchase, and the website the purchase takes place at is equivalent to the claimed purchase information. Applicants have amended the claims to specify that the purchase information is for a good or service purchased by the user. In addition, the claims provide that the purchase information that is stored is obtained through the user communicating with the set top box. Further, the claims now provide that in addition to transmitting the purchase information, the set top box transmits a smart card identification number to the server. Accordingly, the claims provide that the purchase information is not merely a serial number but instead includes information obtained from a user relating to a purchase of a good or service. Further, the claimed purchase information is also not merely a URI for a web site where a purchase may be conducted but instead is information obtained from a user relating to a purchase.

In Nakano, a smart card may contain a unique serial number (for the card) and may also contain a preprogrammed URI for a server the user can shop at (see paragraph {0033}). However, unlike the present claims, the unique serial number is clearly distinguishable from and is different from the purchase information that is claimed. In this regard, by claiming the transmission of both purchase information and a serial number, the claims clearly provide that the serial number is

different from the purchase information. In addition, Nakano's URL is not equivalent to and does not teach, disclose, or suggest, implicitly, or explicitly, the purchase information. As claimed, the purchase information is obtained through communication with a user. However, in Nakano, the URL is pre-stored on the smart card and distributed to the user such that when the user inserts the smart card into the set top box, the customer is connected to the sever (see paragraphs [0033]-[0034]). In this regard, Nakano's URL is not obtained through interaction with a user. Instead, it is pre-programmed in the card.

Applicants note that examples of the purchase information that may be stored on the smart card can identify the particular purchase made by the user (e.g., for a pay-per-view program or electronic commerce transaction). It is this purchase information that is obtained from the user and stored on the smart card that is transmitted to the server. Nakano completely fails to teach such obtaining, storage and transmittal. Again, the present invention is directed towards leveraging an Internet (or data paging network) to transmit information relating to a user-made purchase to a server. A smart card in a set top box is used to store the information until the Internet connection is established at which point the purchase information stored on the smart card is transmitted to the appropriate server. Nakano clearly fails to teach any such invention, implicitly or explicitly. Instead, Nakano teaches the storage of a URL on a smart card that has an ID and when a user inserts a smart card, the user is connected with the URL. Such a teaching is not remotely equivalent nor similar to the invention as claimed.

Original claims 5, 18, and 31 were directed towards the smart card. In rejecting these claims, the Office Action relied on Nakano paragraphs 29 and 33. The amended claims now include smart card limitations. However, Applicants note that the smart card limitations are very detailed in that the information that is stored on the smart card is obtained from a user and that same information is transmitted across the Internet to a server. Paragraphs 29 and 33 fail to teach such limitations with respect to the smart card. Instead paragraph [0029] merely describes that information can be stored and read from a smart card. Further, paragraph [0029] describes that information can be downloaded and stored on the smart card and may also contain a serial number. However, such a teaching does not even remotely describe an interactive purchase made by a user wherein purchase information obtained from such a purchase is stored on the smart card. Instead, paragraph [0029] merely supports the concept that URL can be stored on the smart card before the card is given to

the user. In fact, Nakano specifically describes a shopping service handing out or mailing the smart card with the Internet URL for the service's website stored on the smart card (see paragraph [0032]). Such a teaching is completely contrary to the teaching of the present invention where the information that is stored on the smart is obtained from a user during a purchase and is not pre-stored before a purchase is conducted.

Applicants also submit that the other references also fail to cure the deficiencies of Nakano. In view of the above, Applicants submit that the various elements of the Applicants' claimed invention together provide operational advantages over the systems disclosed in Nakano, Hayward, Kuo, and Yuen. In addition, Applicants' invention solves problems not recognized by Nakano, Hayward, Kuo, and Yuen.

#### IV. Dependent Claims

Dependent claims 2-4, 6-12, 15-17, 19-25, 28-30, and 32-38 incorporate the limitations of their related independent claims, and are therefore patentable on this basis. In addition, these claims recite novel elements even more remote from the cited references. Accordingly, the Applicants respectfully request that these claims be allowed as well.

V. Conclusion

In view of the above, it is submitted that this application is now in good order for allowance and such allowance is respectfully solicited. Should the Examiner believe minor matters still remain that can be resolved in a telephone interview, the Examiner is urged to call Applicants' undersigned attorney.

Respectfully submitted,

  
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Date: December 2, 2004

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